

KCC 4803
K-C 16,436
PATENT

REMARKS

Applicants have thoroughly considered the Examiner's remarks. Reconsideration of application claims 24-27, 33, 39, 41-48, as previously amended and presented, in view of the following remarks is respectfully requested.

Applicants thank the Examiner for the withdrawal of the rejection of Claim 33 under 35 U.S.C. §101.

The following remarks will follow the sequence of the Office action.

Claims 24-27, 33, 39, 41, 42 and 44-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Direct Marketing in view of Froseth and further in view of Schilling.

The Examiner argues that the combination of the three cited references teaches "a method in which a manufacturer produces a plurality of custom tissues within a custom package for a consumer..." Applicants respectfully disagree. These references do not teach the combinations recited by the claims. In particular, Applicants' invention relates to a method and system in which the consumer selects both an absorbent paper product feature and a graphical package feature so that the result is both features are customized by the consumer and, thus, coordinated by the consumer. In particular, each independent claim recites that the second option is graphical and that the product has both the first and second options as selected by the consumer. See the following claim language that relates to coordination of both options:

Claim 24: "such that the produced custom tissues have the first option and the produced package has the second graphical option..."

Claim 33: "providing the custom absorbent paper product embodying the first selected graphic design and having the

KCC 4803
K-C 16,436
PATENT

packaging embodying the second selected graphic design only to said consumer..."

Claim 41: "providing to the consumer the produced absorbent paper product having the first option and with the packaging having the identified second graphical option in accordance with the information collected from the consumer..."

Claim 42: "such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option..."

Claim 43: "such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option..."

Claim 44: "such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option..."

The Examiner has failed to cite any reference that suggests that both product and packaging options can be selected by the consumer and, thus, coordinated by the consumer.

In contrast to the claimed invention, the three cited references are inconsistent with each other and teach away from the invention. Thus, it is clear that the Examiner is using hindsight analysis to selectively combine the references without a teaching to suggest the combination. Without such a teaching, the obviousness rejection falls short and must be withdrawn.

"[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann MaschinenFabrick GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1462; 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). As will be pointed out below, the non-analogous teachings of the prior art relate to different fields of endeavor and are

KCC 4803
K-C 16,436
PATENT

directed to entirely different problems. Therefore, nothing in the cited references suggests their combination. Indeed, the Examiner failed to cite any basis whatsoever for combining these references. In fact, the Examiner's rejection provides a textbook example of impermissible hindsight analysis -- the Examiner used the invention as defined by the claims as a guide to pick and choose non-analogous references in order to reject the claims. See In re Oetiker, 977 F.2d at 1447; 24 U.S.P.Q.2d at 1446 (Fed. Cir. 1992) ("There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.").

The three references relate to different fields of endeavor.

The Direct Marketing reference relates to the field of toilet paper imprinted with a name or photograph and is silent as to graphical packaging features. Direct Marketing does not relate to selecting an absorbent paper feature and a graphical packaging feature, as does the invention. The Froseth reference relates to the field of customized food selection and particularly ingredients therefor and is silent as to both customized paper features and customized packaging features. Froseth has nothing to do with absorbent paper features or a graphical packaging feature, as does the invention. The Schilling reference relates to a custom package printing process and is silent as to custom features of the package contents. Schilling does not relate to selecting an absorbent paper feature and a graphical packaging feature coordinated therewith, as does the invention. Furthermore, none of these references relate to a custom absorbent paper product production machine or method as recited by the invention.

KCC 4803
K-C 16,436
PATENT

The three references are directed to entirely different problems. The Direct Marketing reference is directed to solving the problem of providing toilet paper imprinted in a particular way. It does not relate to coordinating both an absorbent paper feature and a graphical packaging feature, as does the invention. The Froseth reference is directed to solving the problem of providing food with particular ingredients, which ingredients dictate the packaging. It does not even recognize that product features and graphical packaging features can be coordinated, as does the invention. The Schilling reference is directed to solving the problem of specifying custom packaging. It does not even mention product features or their coordination with graphical packaging features, as does the invention.

The teachings of the three references are inconsistent with each other and teach away from the invention. The Direct Marketing reference teaches away from the invention by failing to even mention anything about packaging. Thus, packaging is unimportant according to Direct Marketing as compared to customized packaging, as taught by the invention. The Froseth reference teaches away from the invention by suggesting that the selected ingredients dictate what is printed on the box. Thus, Froseth teaches that the printed box is dictated by its contents rather than selected by the consumer and coordinated by the consumer, as taught by the invention. The Schilling reference teaches away from the invention by failing to even mention anything about customized product features. Thus, package contents are unimportant according to Schilling as compared to customized contents, as taught by the invention. In summary, no references suggest both product and packaging options.

KCC 4803
K-C 16,436
PATENT

The Examiner's argument that the type of product is given little patentable weight is contrary to the plain language of the claims and unsupported. Applicant does not specify any product by "such as facial tissues and/or absorbent paper products." To the contrary, the claims recite:

Claim 24: custom tissues
Claim 33: absorbent paper product
Claim 41: absorbent paper product
Claim 42: custom absorbent paper product
Claim 43: custom absorbent paper product
Claim 44: custom absorbent paper product

The above claim language, which appears in the body of each claim, patentably distinguishes over the cited prior art relating to food, packaging or fragrance systems. Applicants demand that the Examiner cite a reference which would suggest a method or system of the invention including the above specified products or withdraw the rejection.

Regarding claims 45-48, the combination of product graphic design with packaging graphic design selected via a communications network is recited. In contrast, it is noted that Froseth and Schilling suggest access via the Internet to select only ingredients and to select only package printing, respectively, and Direct Marketing is silent as to product graphic design. Thus, no reference cited by the Examiner teaches either (1) selecting product graphic design via the Internet or (2) selecting both product graphic design and packaging graphic design via the Internet.

In summary, claims 24-27, 33, 39, 41, 42 and 44-48 are patentable over the three applied references because the combined references do not teach a method and system in which

KCC 4803
K-C 16,436
PATENT

the consumer selects both an absorbent paper product feature and a graphical package feature resulting in both features being customized by the consumer and, thus, coordinated by the consumer.

Claim 43 stands rejected for the reasons noted above and further in view of Wilmott. The Examiner argues that Wilmott teaches a production machine including a fragrance. Claim 43 is patentable for the same reasons that claims 24-27, 33, 39, 41, 42 and 44-48 are patentable. Furthermore, the combination of Wilmott with the other three references is without any support. As with the other references, the non-analogous teachings of the prior art relate to different fields of endeavor and are directed to entirely different problems. Therefore, nothing in the cited references suggests their combination. Wilmott is a cosmetic production system and method which solves the problem of customized cosmetics. Applicants are at a total loss as to understanding why someone would selectively combine a cosmetics production system with a food production system (Froseth), a package printing system Schilling) and imprinted toilet paper to result in the invention. The Examiner is requested to cite a reference which suggests this selective combination or withdraw the rejection.

REQUEST TO WITHDRAW FINAL REJECTION

On page 9 of the Office action, the Examiner seems to suggest that part of the basis for the rejection is the Examiner's assertion that "the ability to shop online and customize a product by selecting several features was old and well known..." The Examiner cites MPEP 2144.03 regarding common knowledge or well known art. However, contrary to MPEP 2144.03, the Examiner has failed to take Official Notice of this

KCC 4803
K-C 16,436
PATENT

assertion. In addition, contrary to MPEP 2144.03, this assertion has not been stated as a basis for the rejection. The Examiner has stated only that the claims are rejected based on Direct Marketing, Froseth, Schilling and Wilmott. Thus, MPEP 2144.03 is not applicable.

If the Examiner is basing the rejection on this assertion of common knowledge or well known art, the Final Rejection is inaccurate and incomplete and must be withdrawn because common knowledge or well known art is not stated as a basis for rejecting any claims. Furthermore, Applicants traverse this assertion and demand that the Examiner cite a reference to support the assertion.

If the Examiner is not basing the rejection on this assertion of common knowledge or well known art, it appears that the Examiner has no basis for combining the references. In this case, the Final Rejection must be withdrawn as incomplete. Also, if the Examiner is not basing the rejection on this assertion of common knowledge or well known art, the reason for combining the references is ambiguous or the statement on page 9 is ambiguous. In either of these cases, the Final Rejection must be withdrawn as ambiguous.

KCC 4803
K-C 16,436
PATENT

CONCLUSION

Applicants submit that claims 24-27, 33, 39 and 41-48 are patentable over the prior art so that the rejection must be withdrawn. The Examiner has failed to apply any references which would suggest the application of the teachings of Froseth, Schilling and Wilmott to the Direct Marketing reference in the context of coordinating product options and graphical packaging options for absorbent paper products. In addition, none of the applied references teach selecting graphic features of both the product and packaging, as recited by some of the dependent claims. In addition, the Examiner has failed to apply any references which illustrate a custom absorbent paper product production machine. Thus, the applied references cannot be combined and, in any case, the combination of applied references does not read on or otherwise make the claims obvious.

In addition, the Final Rejection must be withdrawn for the reasons noted above regarding MPEP 2144.03.

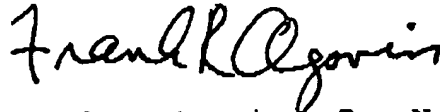
It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

It is believed that no fees are due in connection with this Response To Final Office Action. If, however, the Commissioner

KCC 4803
K-C 16,436
PATENT

determines that there are fees due regarding this Response To
Final Office Action, he is authorized to charge Deposit Account
No. 19-1345.

Respectfully submitted,



Frank R. Agovino, Reg No.27,416
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

FRACwa